

REMARKS

Applicants respectfully request consideration of the subject application.

This Response is submitted in response to the Office Action mailed December 12, 2007. Claims 30-57, 59-61 and 63-65 are rejected. In this Amendment, claims 30, 36, 46, 52-53 and 57 have been amended. Claims 61 and 63-65 have been canceled. Claim 66 has been added.

Applicants thank the Examiner and Supervisory Patent Examiner for the Interview dated March 21, 2007. Applicants also thank the Examiner for the follow-up phone conversations, including the phone conversations of March 29, 2007 and April 9, 2007.

35 U.S.C. § 103 Rejections

The Examiner has rejected claims 30-57, 59-61 and 63-65 under 35 U.S.C. § 103(a) as being unpatentable over Sirimanne, et al. (U.S. Patent No.: 6,356,782, hereinafter "Sirimanne") in view of Schweikard, et al. (U.S. Patent No.: 6,144,875, hereinafter "Schweikard"). It is submitted that claims 30-57 and 59-60 are patentable over the cited reference for one or more of the reasons provided below.

As noted above, Applicants have amended the independent claims. As discussed in the phone conversation with the Examiner on April 9, 2007, the

Examiner indicated that the amendments would overcome the rejections of Sirimanne over Schweikard.

In particular, Applicants submit Sirimanne fails to disclose a fiducial that penetrates tissue. Sirimanne, instead, is directed to a fiducial that fills a cavity or lesion.

In the phone conversation of March 29, 2007, the Examiner directed Applicants to U.S. Patent No. 6,261,243 to Burney and various patents to Foerster. Applicants identified U.S. Patent No. 5,902,310 to Foerster and U.S. Patent No. 6,228,055 (and its related patents) as representative Foerster patents.

Foerster '055 and Foerster '310 fail to disclose all of the limitations of the independent claims.

Foerster '055 and Foerster '310 disclose implantable marker elements. The marker elements of Foerster '055 require a compressive or tensile force to expand the marker elements into their anchored shape. The marker elements of Foerster '310 are connected to a pull wire in deployment. The pull wire is broken to release the marker for implantation.

Each of the marker elements in Foerster '055 and Foerster '310 do not include anchor members withdrawn into a housing of the fiducial in an

unanchored position and withdrawn from the housing of the fiducial in the anchored position.

Moreover, Applicants submit there is no motivation to modify Foerster '055 or Foerster '310 to arrive at a fiducial having an anchor member withdrawn into a housing of the fiducial in an unanchored position and withdrawn from the housing of the fiducial in the anchored position. Neither Foerster '055 nor Foerster '310 disclose fiducials having a body and an anchor member. Instead, in each of Foerster '055 and Foerster '310, the body itself penetrates into tissue.

In addition, one of skill in the art would not modify the marker elements of Foerster '055 or Foerster '310, because the devices would become inoperative. Part of the body of the marking elements of Foerster '055 or Foerster '310 would be required to have a housing for a different part of the body. The body would have to fold itself in half to accomplish this; however, none of the references disclose a marking element material having sufficient flexibility. Foerster merely discloses using shape memory alloy or other similar materials that are not capable of folding in such a manner. See, e.g., MPEP §§ 2143.01 and/or 2143.02.

Burney also fails to disclose all of the limitations of the independent claims.

Burney is directed to a biopsy-marking assembly. The marking assembly includes a biopsy device and a marking element. In Figure 25 of Burney, the marking element includes a rod having sharpened surface projections between a flattened valley area. The marking element may also include barbs.

Burney does not describe the marker element depicted in Figure 25 as having an unanchored position and anchored position. In addition, Burney does not describe housings in which the barbs or projections are withdrawn at any point. Instead, Burney indicates that the flattened valley area is provided between the surface projections.

Therefore, Burney does not disclose a fiducial having an anchor member withdrawn into a housing of the fiducial in an unanchored position and withdrawn from the housing of the fiducial in the anchored position.

In addition, Burney provides no teaching why one of skill in the art would modify Burney to include a housing into which an anchor member is withdrawn in an unanchored position and from which the anchor member is withdrawn in an anchored position. It appears from the description of Burney that the marker element of Figure 25, in fact, only has one position.

Thus, the cited art fails to teach or suggest all of the limitations of independent claims 30, 36, 46, 52 and 57. Claims 30-35, 37-45, 47-51, 53-56 and

59-60 depend, directly or indirectly, from one of the foregoing independent claims. Applicants, accordingly, respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

Applicants respectfully submit that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Jennifer Hayes at (408) 720-8300.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 02-2666.

Respectfully submitted,  
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